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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,445

08/11/2006

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EXAMINER

O HERN, BRENT T

ART UNIT

PAPER NUMBER

1783

MAIL DATE

DELIVERY MODE

01/05/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,445	Applicant(s) BEELE, JOHANNES ALFRED	
	Examiner BRENT T. O'HERN	Art Unit 1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-17 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims

1. Claims 1-3 and 5-17 are pending with claims 11-17 withdrawn.

WITHDRAWN OBJECTIONS

2. All objections of record in the Office action mailed 7/19/2010 have been withdrawn due to Applicant's amendments in the Papers filed 12/9/2010 and 10/19/2010.

WITHDRAWN REJECTIONS

3. All rejections of record in the Office action mailed 7/19/2010 have been withdrawn due to Applicant's amendments in the Paper filed 11/2/2010.

NEW REJECTIONS

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

5. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. The phrase "in such a high amount" in claim 1, line 12 is vague and indefinite as it is unclear what "high amount" of material will create a crust when exposed to a fire. Applicant is advised to set forth a specific amount as disclosed in the Specification.

Clarification and/or correction is required.

Claim Rejections - 35 USC § 103

7. Claims 1-3, 5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordts et al. (US 2004/0093814) in view of Atkinson et al. (GB 2226033A), Beele (US 5,344,106) and Horacek et al. (US 5,232,976).

Regarding claims 1-2, Cordts ('814) teaches a system comprising first and second fire-resistant parts for at least temporary fire-resistant sealing of an opening in a wall (*See Abstract, paras. 21-31,34-38 and FIGs 1 and 3, cover assembly 2, with fire-resistant overlapping slats 16, side members 18, frame 14, riser 10, stop material 30 and putty along the perimeter of the sheets. See also the fire-resistant barrier material disclosed at para. 38. The system is designed to stop fire and be tight enough to provide a barrier to smoke.*)

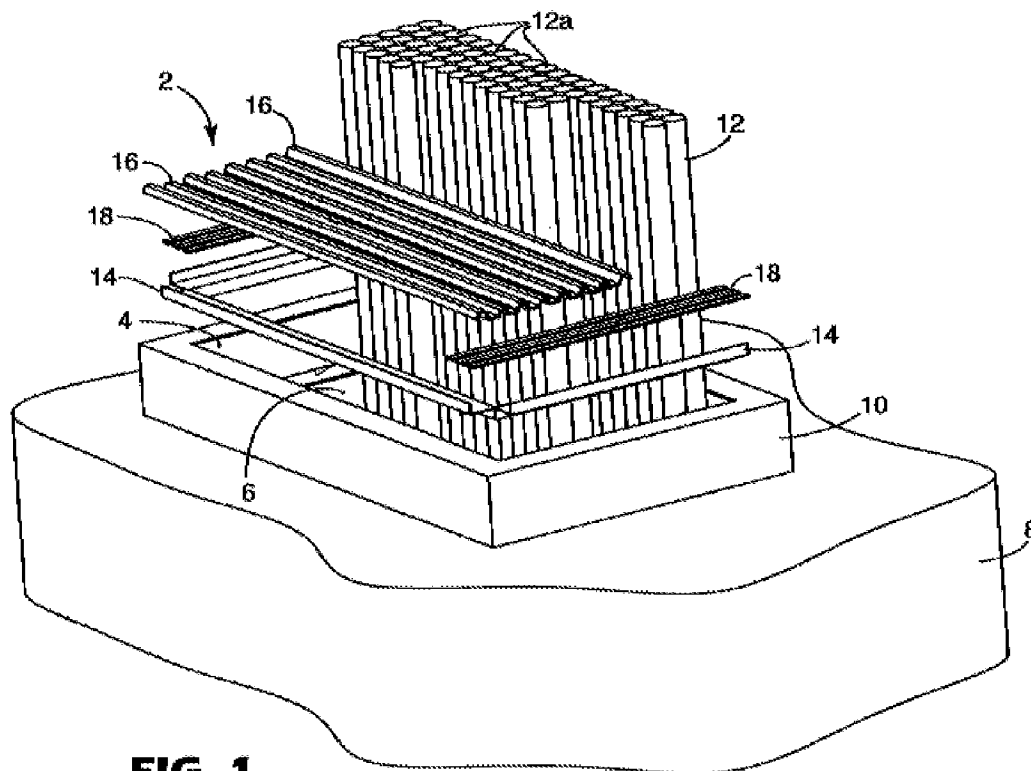


FIG. 1

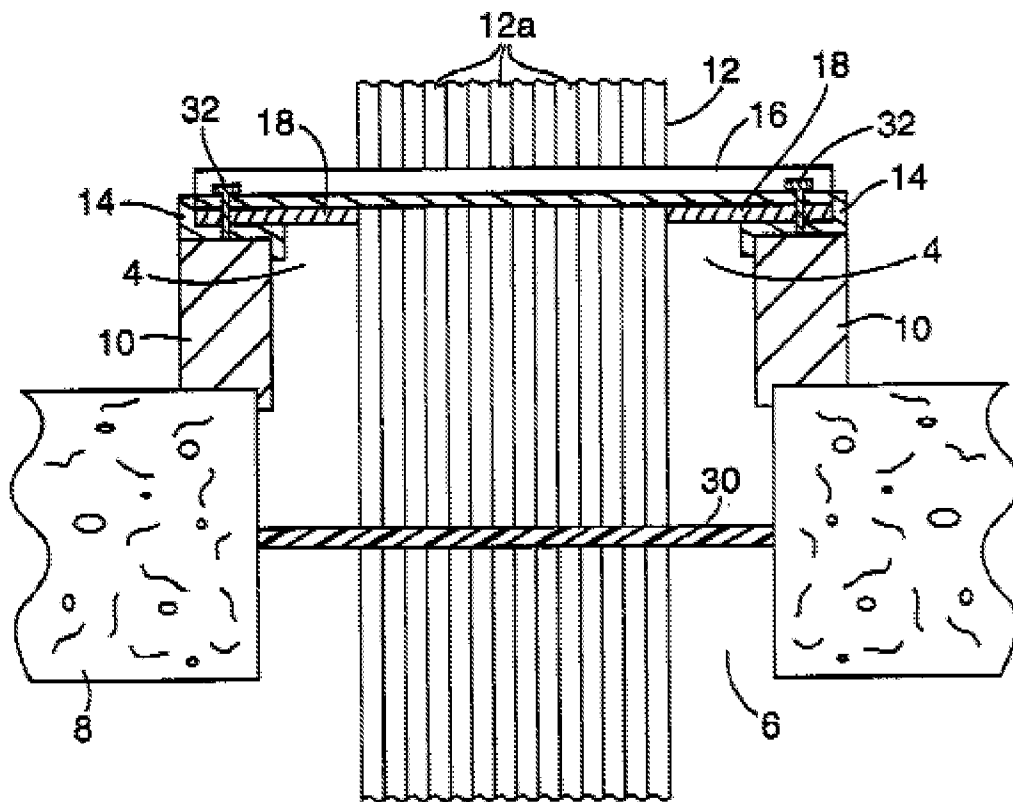


FIG. 3

in which at least one transport device has been fed through, or will be fed through, each of the first and second parts being at least partly placeable in the opening (See FIGs 1 and 3, bundle 12 of items 12a through opening 4 and the fire-resistant materials.), the first parts being designed to at least partly envelop the transport device and the second parts being designed to be placed between the first parts and/or between the first parts and an inner wall of the opening to at least virtually completely seal the opening (See FIGs 1 and 3 and para. 38 where all of the materials are within the opening and at least partly envelop the transport device and are within the wall of the opening. It would have been obvious to adjust the orientation of Cordts' ('814) members based on what and the

Art Unit: 1783

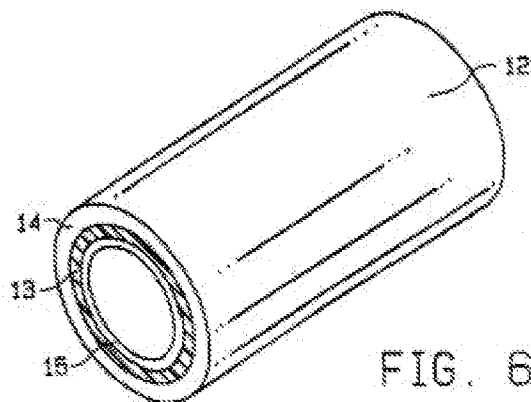
configurations thereof to be inserted through the wall, the location and proximity of particular walkways, doors and various other structures found in environments as disclosed by Cordts ('814).), the first parts being substantially manufactured from a fire-resistant material (See Abstract and paras. 29-33 and 38 where Cordts' ('814) system is designed to be fire-stopping, thus, the materials have sufficient properties to stop a fire and not allow a fire to burn through the members, thus, fire resistant.), the second parts being manufactured from a fire-resistant material based on a graphite elastomeric foam with a substantially closed cell structure that can include a magnesium ammonium phosphate additive (See paras. 29-33 and 38 wherein the barrier is a closed cell foam. Cordts' ('814) materials are designed to be fire-stopping, thus, the materials have sufficient properties to stop a fire and not allow a fire to burn through the members, thus, fire resistant.), however, fails to expressly disclose the first part being rubber, with the foam including at least one crust-forming, fire-retardant material, the foam includes a pH-neutralized graphite material and wherein the fire-retardant material includes polyammonium phosphate or melamine phosphate in such an amount that a fire retardant crust is formed on a side of the foam when exposed to fire.

Atkinson ('033) teaches fire-resistant material including expandable graphite that is similar to Cordts ('814) as discussed above wherein Atkinson's ('033) material includes a combustion modified material comprising a polymer foam incorporating expandable graphite in which a substantially water-insoluble neutralizing substance is incorporated to control the pH value of the material during and after manufacture (See Abstract, p. 2, ll. 1-6, p. 4, l. 9 to p. 5, l. 3.) for the purpose of providing a fire retardant

Art Unit: 1783

material that is neutralized and does not interfere with the performance of the foam material (*See p. 2.*). The outer structure of the foam forms a crust.

Beele ('106) teaches conduits for wall penetrations similar to those disclosed by Cordts ('814) including rubber sleeves (*See col. 4, ll. 1-25 and FIGs 1 and 6, sleeve 12 with expandable fire resistant layers 14 and 16.*)



wherein in case of a fire the sleeve will expand by the flow of hot air thereby closing off the flow of air (*See col. 4, ll. 1-25.*).

Horacek ('976) teaches fire-resistant materials similar to those disclosed by Cordts ('814) as discussed above wherein the fire-resistant materials incorporate magnesium ammonium phosphate or melamine and its derivatives and graphite salts into fire-resistant structures that form a crust when exposed to fire (*See col. 2, l. 67 to col. 3, l. 26.*) for the purpose of modifying the fire behavior and completely sealing off openings when they expand in the event of a fire (*See col. 3, ll. 3-8.*). The claims do not set forth a specific amount of material that creates a crust, however, Horacek's ('976) material is capable of forming a crust in the presence of fire, thus, a person having ordinary skill in the art would interpret the amount to be sufficient to seal off the opening

Art Unit: 1783

and thus form a crust when exposed to fire. Horacek ('976) teaches additives can be used that improve the strength of the sealing compound in the expanded state, consolidate the crust and increase the cohesion including inorganic fibers, including mineral fibers or glass fibers, glass powders, vermiculites, bentonites, silica, silicates, borax, starch, sugar, chloroparaffins, aluminum sulfate, hydrated alumina or magnesium hydroxide (*See col. 3, ll. 9-26.*). Flame-proofing agents can be added including halogenated or phosphorus-containing hydrocarbons such as tris-chloropropyl phosphate, dibromoneopentyl glycol or antimony trioxide (*See col. 3, ll. 9-26.*). These additives can be used to assist in increasing the foam formation in the event of flame action. Examples of these are salicylic acid, p-hydroxybenzoic acid, PVC and also nitrogen hydrazides or sulfo hydrazides, triazoles, urea-dicarboxylic anhydride and ammonium carbonate (*See col. 3, ll. 9-26.*).

Therefore, it would have been obvious to a person having ordinary skill in the art with Beele ('106), Atkinson ('033), Horacek ('976) and Cordts ('814) before them to use the fire-resistant materials as taught by Beele ('106), Atkinson ('033) and Horacek ('976) in Cordts ('814) in order to provide system with a sealing material and foam that are fire resistant without an acid interfering with the performance of the material that closes the flow of air.

Regarding claim 3, Cordts ('814) teaches wherein the graphite material expands at a temperature higher than 200 °C (*See para. 33.*).

Regarding claim 5, Cordts ('814) teaches wherein at least one of the second parts is designed in the shape of a plate-shaped element or a beam-shaped element (*See FIGs 1 and 3.*).

Regarding claim 7, Cordts ('814) teaches wherein at least one of the first parts is sleeve-shaped and includes a slot to allow the at least one of the first parts to be placed around the transport device (*See FIGs 1 and 3. The claims do not describe the shape of the sleeve.*). Beele ('106) also teaches a sleeve (*See FIG-6, sleeve 12.*).

Regarding claim 8, Cordts ('814) teaches wherein the at least one of the first parts is constructed and arranged to allow longitudinal edges of the slot to permanently overlap each other under the influence of material stress (*See FIGs 1 and 3.*).

Regarding claim 9, Cordts ('814) teaches wherein at least two of the first parts are designed such that the at least two of the first parts can together form a sleeve that is placeable around the transport device (*See FIGs 1 and 3. The claims do not describe the shape of the sleeve.*). Beele ('106) also teaches a sleeve (*See FIG-6, sleeve 12.*).

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cordts et al. (US 2004/0093814) in view of Atkinson et al. (GB 2226033A), Beele (US 5,344,106), Horacek et al. (US 5,232,976) and Fay (US 6,484,463).

Cordts ('814), Atkinson ('033), Beele ('106) and Horacek (976) teach the system discussed above, however, fail to expressly disclose wherein at least one of the second parts is part of a plate-shaped material that includes a weakening line along-which at least one of the second parts can be detached.

However, Fay ('463) teaches insulation material including lines along which the parts can be detached (*See col. 4, l. 52 to col. 6, l. 2 and FIG-2, where the members of the structure can be detached along 34, 36 and 38.*) for the purpose of separating the members without a cutting tool (*See col. 5, ll. 1-8.*).

Therefore, it would have been obvious to provide Cordts' ('814) parts with weakening lines as taught by Fay ('463) in order to provide a means to separate the members without a cutting tool.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cordts et al. (US 2004/0093814) in view of Atkinson et al. (GB 2226033A), Beele (US 5,344,106), Horacek et al. (US 5,232,976) and Massey (US 4,361,721).

Cordts ('814), Atkinson ('033), Beele ('106) and Horacek ('976) teach the system discussed above, however, fail to expressly disclose a lubricant which can be applied to a surface of each of the first and/or second parts.

Massey ('721) teaches applying lubricants to cables that are jacketed with fire-resistant sheaths (*See Abstract, col. 5, ll. 11-20 and col. 1, ll. 11-22.*) to make it easier to insert them in a passageway (*See col. 5, ll. 11-20.*).

Therefore, it would have been obvious to apply a lubricant as taught by Massey ('721) to a surface of Cordts ('814) parts in order to make it easier to insert cables in passageways.

ANSWERS TO APPLICANT'S ARGUMENTS

10. Applicant's amended Specification filed 12/9/2010 is acknowledged.

11. In response to Applicant's arguments (*See p. 6 of Applicant's Paper filed 12/9/2010 and p. 7 of Applicant's Paper filed 10/19/2010.*) regarding the objections, it is noted that that the amendments overcome all objections.
12. Applicant's arguments (*See p. 8, paras. 1-2 of Applicant's Paper filed 10/19/2010.*) regarding the amendments to claim 1 and Applicant's summary of the last Office action are acknowledged.
13. Applicant's arguments (*See p. 8, para. 3 of Applicant's Paper filed 10/19/2010.*) regarding the teachings of Cordts are acknowledged. It is noted that Cordts teaches the foam being closed foam (*See para. 38.*).
14. Applicant's arguments (*See p. 9, para. 1 of Applicant's Paper filed 10/19/2010.*) regarding the teachings of Atkinson are acknowledged.
15. In response to Applicant's arguments (*See p. 9, para. 2 of Applicant's Paper filed 10/19/2010.*) that Applicant does not know which of Cordts parts are the first and second parts, it is noted as discussed above that Cordts ('814) teaches a system comprising a plurality of fire-resistant parts for sealing an opening in a wall (*See paras. 21-31, 34-38 and FIGs 1 and 3, cover assembly 2, with fire-resistant overlapping slats 16, side members 18, frame 14, riser 10, stop material 30, putty and the fire-resistant barrier material disclosed at para. 38.*). The parts are not limited to those illustrated in the FIGs but also include those described in the cited paragraphs. The second parts are those parts including the barrier material based on a graphite elastomeric foam with a substantially closed cell structure that can include a magnesium ammonium

phosphate additive that are disclosed at paras. 29-33 and 38. The first parts include the parts other than the second parts.

16. In response to Applicant's arguments (*See p. 9, para. 3 of Applicant's Paper filed 10/19/2010.*) that there is no reason to make Cordts' materials out of fire resistant as claimed because Cordts materials need to be rigid enough to protect an opening from foot traffic. It is noted as discussed above, that Cordts materials need to be fire-resistant (*See Abstract.*) and usable for penetrations in walls, ceilings and floors (*See para. 1.*). Cordts teaches there being multiple members used to close the opening and whether the system is required to be rigid does not prohibit the material from being fire-resistant. Cordts' system of parts is fire resistant.

17. In response to Applicant's arguments (*See p. 10, para. 1 of Applicant's Paper filed 10/19/2010.*) that the combination of references do not teach first parts that at least partly envelop the transport device and the second parts are placed between the first parts and the inner wall because neither the slats 16 nor the barrier are placed between the first stop material 30 and the inner wall in the opening illustrated in FIG-3, it is noted that said arguments are not persuasive. As discussed above, Cordts' conduits are completely enveloped by the various members to the extent that fire and smoke are stopped (*See FIGs 1 and 3.*). Cordts teaches (*See FIGs 1 and 3 and para. 38.*) where bundle 12 of items 12a are through opening 4 and the fire-resistant materials are within the opening, thus, at least partly enveloping the transport device and the second parts being designed to be placed between the first parts and/or between the first parts and an inner wall of the opening to at least virtually completely seal the opening.

Art Unit: 1783

18. In response to Applicant's arguments (*See p. 10, paras. 2-3 of Applicant's Paper filed 10/19/2010.*) that Cordts and Atkinson do not teach a fire-resistant material based on a foam with a closed structure but rather a barrier material that blocks smoke, it is noted that said arguments are not persuasive as Cordts expressly teaches the foam being closed foam and the system stopping fire (*See Abstract and para. 38.*). Just because a material is able to block smoke does not mean that the material can not also be fire-resistant.

19. In response to Applicant's arguments (*See p. 11, para. 3 to p. 12, para. 3 of Applicant's Paper filed 10/19/2010.*) that Cordts and Atkinson do not teach the new limitations per amended claim 1, it is noted that these new limitations are discussed above. Horacek teaches fire-resistant materials similar to those disclosed by Cordts as discussed above wherein the fire-resistant materials incorporate magnesium ammonium phosphate or melamine and its derivatives and graphite salts into fire-resistant structures that form a crust when exposed to fire (*See col. 2, l. 67 to col. 3, l. 26.*).

20. In response to Applicant's arguments (*See pp. 12-13 of Applicant's Paper filed 10/19/2010.*) that the cited prior art does not teach the dependent claims because independent claim 1 is allowable, it is noted that said arguments are not persuasive for the reasons discussed above. No further precise arguments are set forth.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT T. O'HERN whose telephone number is (571)272-6385. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1783

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BRENT T O'HERN/
Examiner, Art Unit 1783
January 2, 2011